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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,491	02/02/2000	Detlef Groth	BEIERSDORF-606-WCG	6328

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EXAMINER

VARGOT, MATHEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 05/20/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/496,491

Applicant(s)

GROTH et al.

Examiner

M. VARGOT

Group Art Unit

1732

- The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 3/12/03
- ☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3, 6, 7, 9 + 10

Of the above claim(s)

- ☐ Claim(s) _____ is/are pending in the application.
- ☒ Claim(s) 1-3, 6, 7 + 10 is/are withdrawn from consideration.
- ☒ Claim(s) 9 is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received.
- ☐ Copies of the certified copies of _____ in this national stage are _____

*Certified copies not received

Attachment(s)

- ☐ Information Disclosure
- ☐ Notice of Reference
- ☐ Notice of Prior Art

Art Unit: 1732

1. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by McGrew (col. 2, lines 36-37 and lines 53-60; col. 3, lines 39-41 and line 46; col. 4, line 15).

McGrew discloses the instant process for making a sheet bearing a hologram by embossing a polyester support foil with holographic structures, providing a sheet of plastic material onto the foil by coating same, curing the plastic material using UV or electron beam curing and removing the support foil. Note that the use of the polyester film is "preferable" so that the back of the hologram is smooth to facilitate viewing thereof. However, one of ordinary skill in this art would know that such would be dispensed with should one not desire such a smooth back surface. At any rate, the use of such a film is not seen to materially affect the process and hence the instant claims remain anticipated, in spite of the "consisting essentially of" language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 1732

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McGrew essentially for reasons of record noting the following. Claims 6 and 7 are rejected for reasons of record. While it is recognized that McGrew teaches a final step of metallization, one of ordinary skill in the art would recognize that such a step would have been performed during the providing of the sheet or simply not performed, depending on the desired reflectivity for the final hologram and product. Like the employment of the polyester film, the metallization is submitted to have been a step that does not materially affect the process and hence would have been within the skill level of the art to perform or not. On this basis, new claim 10 is submitted to have been obvious over McGrew.

4. Applicant's arguments filed March 12, 203 have been fully considered but they are not persuasive. Applicant's comments that McGrew does not anticipate claims 1-3 and can not teach the limitation of instant claim 10 because McGrew employs steps not set forth in the instant claims which employ "consisting essentially of" language is not persuasive for reasons already given. The "consisting essentially of" language only limits the scope of the claims to the specified steps and those that do not materially affect the basic and novel characteristics of the claimed invention. In this case, using a smooth polyester film and metallization are submitted to not materially affect the process.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1732


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

May 16, 2002


MATHIEU D. VARGOT
PRIMARY EXAMINER
GROUP 1300
5/16/03